

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

In re application of David L. Kaminsky, et al.

November 13, 2007

Serial No.: 10/654,786

Filed: September 4, 2003

For: Policy-Based Management of Instant Message Windows

Art Unit: 2155

Examiner: Kevin T. Bates

**APPELLANTS' BRIEF ON APPEAL**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is an Appeal seeking reversal of the decision of the Primary Examiner, finally  
rejecting all current claims of the subject patent application.

### **1) REAL PARTY IN INTEREST**

The real party in interest is the Assignee, International Business Machines Corporation (“IBM”).

### **2) RELATED APPEALS AND INTERFERENCES**

Commonly-assigned and related application 10/655,526 (attorney docket RSW920030202US1) is also under appeal. This related application shares some claim terminology with the present application, and references cited against the present and related application have an inventor in common (namely, Horvitz), although these cited references are different patent applications by Horvitz. Accordingly, the appeal of the related case may possibly affect, or have a bearing on, the Board’s decision in the pending appeal. No other appeals, and no interferences, are personally known to Appellants, Appellants legal representative, and the assignee that will directly affect or be directly affected by or have a bearing on the Board’s decision in the pending appeal.

### **3) STATUS OF CLAIMS**

Claims 1, 9, 15, and 28 - 29 stand rejected. Claims 2 - 8, 10 - 14, and 16 - 27 have been cancelled from the application without prejudice. Claims 1, 9, 15, and 28 - 29 are under appeal.

### **4) STATUS OF AMENDMENTS**

An Amendment After Final was filed on August 14, 2007, responsive to the Final Rejection mailed on July 9, 2007. The Amendment After Final was entered by the Examiner, according to the Advisory Action dated August 17, 2007.

## 5) SUMMARY OF CLAIMED SUBJECT MATTER

1. Appellants' independent Claim 1 is a method claim directed toward instant messaging, and in particular, using policy information in responding to arrival of instant messages (Claim 1, line 1; Specification, p. 6, lines 9 - 10). An instant messaging ("IM") user defines policy information comprising criteria for responding to arrival of instant messages (Claim 1, lines 3 - 4; Specification, p. 11, lines 1 - 2). In particular, the policy comprises a list of application programs (other than the IM application itself) that are executable on the IM user's computing device (Claim 1, lines 4 - 6; Specification, p. 12, lines 1 - 2 and lines 7 - 9). If an instant message arrives (Claim 1, lines 7 - 8), the policy is used to determine whether or not a new IM window is opened for displaying that newly-arriving instant message (Claim 1, lines 9 - 16; Specification, p. 20, lines 12 - 15; see also Specification, p. 6, lines 11 - 12 and p. 7, lines 2 - 3). In particular, this comprises determining whether any of the applications from the list are currently executing (Claim 1, lines 9 - 10; Specification, p. 12, lines 7 - 9); if none of the applications is executing, then the newly-arriving instant message is displayed in a new window (Claim 1, lines 12 - 14, for the "negative result" case; Specification, p. 12, lines 7 - 9), but if any of those applications is/are executing, then instead of opening a new window, an icon representing this message is added to an already-open window (Claim 1, lines 14 - 16, for the "positive result" case ; Specification, p. 12, lines 7 - 9 and p. 17, lines 16 - 18; see also paras. 3 - 4, below).

2. Claim 1 further states that the newly-received instant message is from an IM sender who is not already participating in an IM session with the (recipient) user (Claim 1, lines 7 - 8). Newly-arriving messages from such already-participating IM senders will be displayed in the already-

open window for that IM session (Specification, p. 11, lines 16 - 19), and thus are outside the scope of the present invention as claimed in Claim 1.

3. In addition to the functionality discussed above in paragraph 1, Claim 1 further specifies that the already-open window to which an icon is added (i.e., in the case where an application or applications from the list is/are currently executing) comprises an already-open buddy list window that visually depicts a list of the IM partners from an IM address book (Claim 1, lines 17 - 18), or an already-open status window that visually depicts a list of each currently-active IM partner (Claim 1, lines 19 - 20). In this manner, the “visual clutter” that results using a prior art approach – where a new window opens for each new IM session – may be avoided when using the present invention (Specification, p. 12, lines 18 - 19). The user may also experience less distraction by having fewer IM windows popping up on his display when using the present invention.

Specification, p. 12, lines 18 - 21. See, for example, **Figs. 1 - 3**. In contrast to the cluttered display **100** of **Fig. 1**, where a prior art approach pops up new windows illustrated at **120**, **130**, and **150** for each new IM session, **Fig. 2** illustrates the display of icons in an already-open window **200** according to the present invention, where these icons are placed in already-open window **200** because an instant message arrives while any of the listed applications is/are executing.

Specification, p. 12, lines 18 - 21. **Fig. 3** shows an alternative approach to window **200**, where icons **300**, **310** of **Fig. 3** are added to an already-displayed buddy list or status window that lists several IM partners and partner groups (Specification, p. 13, lines 1 - 4).

4. Claim 1 further states that the icon that is added to the already-open window is added in

association with a representation of the IM sender (i.e., the sender of the newly-arriving instant message which caused the icon to be added; Claim 1, lines 21 - 22; Specification, p. 17, lines 16 - 18), and that this icon visually indicates that the instant message is available for on-request display and can be activated to cause this on-request display (Claim 1, lines 23 - 24; Specification, p. 12, lines 15 - 18 and p. 13, lines 14 - 15). See **Figs. 2 and 3**, where the icons are shaped as an envelope and are depicted “in association with” a name of the instant message sender.

5. Independent Claims 28 and 29 are system and computer program product claims, respectively, which specify limitations analogous to those of Claim 1.

6. Independent Claim 28 includes means plus function terminology. Structure, material, or acts supporting this terminology are described in Appellants’ specification, as will now be described.

7. With regard to the “means for defining ... policy information ...” element on lines 3 - 7 of independent Claim 28, see reference numbers **500, 510** of **Fig. 5** and corresponding text on p. 17, line 9 - p. 18, line 9 and p. 20, lines 3 - 6 (referring, by way of example, to rules stored in a repository). The “means for receiving ...” element on lines 8 - 9 of Claim 28 is described on p. 12, lines 14 - 16 and p. 20, lines 12 - 15 (discussing an inbound message, to be received with the user’s IM system; examples of IM systems are stated on p. 2, lines 7 - 10). The “means for programmatically determining ...” element on lines 10 - 12 of Claim 28 is described on p. 12, lines 7 - 9; p. 20, lines 10 - 15 state that an inbound message [arrival] triggers evaluation of policy/rules

information (including whether to pop up a new window or display an indication in an already-open window). The “means for responding ...” element on lines 13 - 17 of Claim 28 is described on p. 12, lines 1 - 2 (referring to configuring an instant messaging system to programmatically respond). See also p. 20, lines 3 - 6, referring to storing rules in a data repository. In a general sense, see also the discussion on p. 23, line 19 - p. 24, line 7, discussing implementation using hardware, software, a combination of hardware and software, a computer program product embodied on computer-readable storage media, etc.

## **6) GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

8. The ground of rejection presented for review is a rejection of Claims 1, 9, 15, and 28 - 29 under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent Publication 2003/0055908 to Brown in view of U. S. Patent Application 2003/0046421 to Horvitz and further in view of U. S. Patent Publication 2004/0172455 to Green.

## **7) ARGUMENT**

9. Page 2 of the Office Action dated July 9, 2007 (hereinafter, “the Office Action”) states that Claims 1, 28, and 29 are rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent Publication 2003/0055908 to Brown in view of U. S. Patent Application 2003/0046421 to Horvitz and further in view of U. S. Patent Publication 2004/0172455 to Green. All of these claims are independent claims. (Rejection of dependent Claims 9 and 15 is discussed on Page 4 of the Office Action.)

10. Appellants respectfully submit that a *prima facie* case of obviousness under 35 U.S.C. §103 has not been made out as to these claims, as the references, whether taken singly or in combination, do not teach or suggest all the claim limitations.

11. Furthermore, Appellants are entitled to have all words of the claimed invention considered when determining patentability. See Section 2143.03 of the MPEP, “All Claim Limitations Must Be Taught or Suggested”, referencing *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970), which stated “*All words* in a claim must be considered in judging the patentability of that claim against the prior art.” (emphasis added).

#### **7.1) Rejection of Independent Claims 1, 28, and 29**

12. With reference to independent Claim 1, Appellants respectfully note that the analysis of Brown on Page 2 of the Office Action (Office Action, Page 2, last 2 lines), which refers to the “defining” element on lines 3 - 6 of Claim 1, cites para. [0055] as teaching this “defining ... policy information specifying criteria for responding to arrival of instant messages ...”. Appellants respectfully submit that the cited para. [0055] of Brown discusses hardware components illustrated in Brown’s **Fig. 1**, such as an audio output **28** and a keyboard **26**, and has no apparent relevance to Appellants’ claimed “defining ... policy information ...”.

13. Accordingly, the Office Action fails to provide a citation teaching this first element of Appellants’ claimed invention.

14. Appellants also respectfully note that the analysis of Brown provided on Page 3 of the Office Action does not use the claim language from their Claim 1. As one example, lines 2 - 4 on Page 3 state “... determining based on whether the user is busy or can be bothered, whether the window message should be displayed or just stored” (emphasis added). Appellants have not claimed determining “whether the user is busy or can be bothered”, and also have not claimed that a message “should be displayed or just stored” based upon this “is busy or can be bothered” determination.

15. Appellants find no discussion or suggestion in Brown of their claimed “... policy information compris[ing] a list of selected application programs ... which are each executable on a computing device of the IM user” (Claim 1, lines 4 - 6) or “programmatically determining ... whether any of the selected application programs in the list are currently executing ...” (Claim 1, lines 9 - 10).

16. Instead, the cited paragraph [0060] of Brown (cited at Office Action, Page 3, line 4) discusses “each user sending a message request ... may assign a priority value [thereto]” (para. [0060], lines 7 - 9); “each [receiving] user ... provides priority requirements for throughput” (para. [0060], lines 9 - 11); and “determin[ing] ... whether the message request [specifying a sender-specified priority value] meets that [receiver-specified] priority requirement” (para. [0060], lines 13 - 15, emphasis added). Cited para. [0067] (cited at Office Action, Page 3, line 4) has similar information. Appellants’ Claim 1 does not recite use of “priority” requirements, and these cited paragraphs are therefore deemed irrelevant to the limitations recited in Claim 1.

17. Furthermore, the Office Action admits that Brown does not teach “whether any of a selected list of application program are active”. Office Action, Page 3, lines 5 - 6. The Office Action then cites Horvitz, stating “Horvitz teaches a system for determining whether to alert the user of incoming IM messages based on a profile that is dynamically created by the system (Abstract), part of that profile is determining the current application the user is working on (Figure 34, the application in focus).”. Office Action, Page 3, lines 9 - 12.

18. In Appellants’ Amendment After Final dated August 14, 2007 (hereinafter, “Appellants’ response”), Appellants pointed out, with regard to the above-quoted “profile that is dynamically created by the system”, that their claimed “list of selected application programs” is not “dynamically created by the system” but is instead “defin[ed] by an instant messaging ... user” (Claim 1, line 3, emphasis added). Creating something dynamically, by a system, is different from defining something by a user.

19. Appellants’ response further pointed out that, with regard to the above-quoted “... determining the current application the user is working on”, this is not what Appellants have claimed. Instead, Appellants’ Claim 1 recites “... whether any of the selected application programs in the list are currently executing ...” (Claim 1, lines 9 - 10, emphasis added). The user might have several applications executing simultaneously, for example, and Appellants’ claimed “programmatically determining” as recited on lines 9 - 10 makes no reference to which of those programs the user is currently “working on”. In fact, Appellants’ claim language does not specify that the user is “working on” any of the applications from the list: the user might (for example) be

working with his or her instant messaging application while another application or applications from the list is/are also currently executing (and this IM application is explicitly excluded from the list that is considered in the “programmatically determining” at lines 9 - 10; see Claim 1, lines 4 - 6, stating that the application programs in the list “are each distinct from” the instant messaging application).

20. Following Appellants’ response, the Advisory Action dated August 17, 2007 (hereinafter, “the Advisory Action”) stated “Horvitz teaches a system for determining whether the user should be interrupted by messages or not. As part of that determination, the application examines what active applications the user is using, and if the determination is made based on at least in part of the active application, whether the user should be interrupt[ed] or not. So inherently in that teaching, the application in Horvitz has to know what application the user was operating in based on which application it was, it knows whether to interrupt it. So in the user profile there must be information including a data structure of applications that can be or not be interrupted.” Advisory Action, Continuation Sheet (PTOL-303), lines 3 - 7.

21. Appellants respectfully note that the Advisory Action provides no citations to paragraphs of Horvitz. Accordingly, Appellants will now discuss several portions of Horvitz to demonstrate differences from their claimed invention.

22. In para. [0075], lines 17 - 29, Horvitz discusses “deferral options” whereby a user can “configure having messages delivered at a more convenient time”. An example is provided,

stating that “if the user is currently engaged in conversation or busy in a critical meeting as indicated on a calendar or as inferred from a more general inference about the user’s situation or context, gleaned from one or more observations (including the calendar appointment status), the message can be delivered ...” at another time. Appellants respectfully submit that using information from an electronic calendar is clearly distinct from their “whether any of the selected application programs in the list are currently executing” (Claim 1, lines 9 - 10, emphasis added), and that “inferring” a user’s “situation or context” cannot reasonably be interpreted as teaching this functionality from lines 9 - 10 of Claim 1 (without prohibited hindsight reasoning).

23. In para. [0094], Horvitz discusses **Fig. 14**, which provides examples of rules controlling when messages should be sent to the user’s device. Appellants note that these examples include priority of a message, and various things relating to the message’s content, but there is no teaching or any suggestion of “whether any of the selected application programs in the list are currently executing” (Claim 1, lines 9 - 10, emphasis added).

24. In para. [0095], lines 16 - 26, Horvitz discusses feedback and states that it can include monitoring the user and monitoring the user’s “context during interactions with the user interface”, including “the amount of focus and attention a user places on particular e-mails”. Appellants respectfully submit that monitoring how the user interacts with the user interface is distinct from their “whether any of the selected application programs in the list are currently executing” (Claim 1, lines 9 - 10, emphasis added), and that monitoring “the amount of focus and attention a user places on particular e-mails” is also distinct from these claim limitations from lines

9 - 10 of Appellants' Claim 1.

25. In para. [0111], lines 13 - 14, Horvitz discusses **Fig. 26**, which contains an option as to whether a document should “be automatically opened in a window on the screen”. However, it is clear that the criteria used for this decision uses a document priority, and there is no teaching or suggestion of making the determination based on “whether any of the selected application programs in the list are currently executing” (Claim 1, lines 9 - 10, emphasis added). See, for example, the priority settings at reference numbers **2296** and **2298** of **Fig. 26**, which correspond to the delineations between the 3 columns of options that include this “open message” selection.

26. In para. [0112], lines 2 - 8, Horvitz again discusses **Fig. 26**, and in particular the setting at reference number **2293**, stating “if the user is busy, then alerts are deferred until the user is no longer busy” and “... it is first determined whether the user is busy ...”. However, whether the user is “busy” is distinct from “whether any of the selected application programs in the list are currently executing” (Claim 1, lines 9 - 10, emphasis added). For example, the user might be busily interacting with an instant messaging program to which the incoming document is directed, and lines 5 - 6 of Appellants' Claim 1 explicitly except this application program from the list that is considered in the “whether” clause of lines 9 - 10.

27. In paras. [0125] - [0223], Horvitz discusses many different examples of “tokens and/or patterns of value” that can be used “in identifying the criticality of messages” (para. [0125], lines 1 - 2). However, none of these many examples teaches or suggests Appellants' claimed use of

“whether any of the selected application programs in the list are currently executing” (Claim 1, lines 9 - 10, emphasis added) to determine how to respond to an incoming instant message (Claim 1, lines 12 - 16).

28. In para. [0225], Horvitz discusses “monitoring the user work or usage patterns” (lines 3 - 4) and “... when presented with a new e-mail, the user is monitored to determine whether he or she immediately opens the e-mail ... Thus, ... a user is monitored while working or operating a system ...” (lines 9 - 15). However, monitoring how the user processes e-mail is not the same as Appellants’ claimed use of “whether any of the selected application programs in the list are currently executing” (Claim 1, lines 9 - 10, emphasis added) to determine how to respond to an incoming instant message (Claim 1, lines 12 - 16).

29. In para. [0236], Horvitz again refers to the user’s “context” and “based upon one or more observations ... and/or data about past behavior of the user” (lines 5 - 12). However, the examples presented therein of these observations include “the time the user was last seen at a desktop computer, the user’s current appointment status in the calendar, and so forth”, and Appellants respectfully submit that this cannot reasonably be interpreted as teaching Appellants’ claimed “whether any of the selected application programs in the list are currently executing” (Claim 1, lines 9 - 10, emphasis added) without prohibited hindsight reasoning.

30. In paras. [0247] - [0252], Horvitz discusses alternatives to use of “priority as time criticality” (para. [0247], lines 3 - 5) for determining message importance. Such alternatives

include “combinations of high-payoff features” (para. [0248], lines 3 - 5), “date and time of an event specified in a message” (para. [0249], line 2), “an organization chart” (para. [0250], line 2), and so forth. Again, none of these examples teaches or suggests Appellants’ claimed “whether any of the selected application programs in the list are currently executing” (Claim 1, lines 9 - 10, emphasis added) for determining how to respond to an arriving instant message (Claim 1, lines 12 - 16).

31. In paras. [0253] - [0260], Horvitz discusses a user’s distraction in terms of whether the user should be alerted of a new message. However, this discussion pertains to a “cost of distracting the user” (para. [0253], last sentence), such as may be computed by a cost-benefit analysis of information loss if the user does not view the message (para. [0257]). Such techniques are distinct from Appellants’ claimed “whether any of the selected application programs in the list are currently executing” (Claim 1, lines 9 - 10, emphasis added).

32. In para. [0263], Horvitz discusses “how busy the user is” in terms of “interrupting the user with information about messages with high time criticality” (lines 1 - 3, emphasis added).

Appellants respectfully submit that their claimed invention does not specify limitations for “messages with high time criticality”. This paragraph of Horvitz also states “It can be reasoned (e.g. inferential decision-making) about whether ... a user is working on a computer, or whether the user is on the telephone, speaking with someone, or at a meeting ...” (lines 3 - 7). Again, this is not what Appellants have claimed, and does not teach or suggest “whether any of the selected application programs in the list are currently executing” (Claim 1, lines 9 - 10, emphasis added).

This paragraph further states that “Several classes of evidence can be employed to assess a user’s activity or his or her focus of attention, as illustrated in **FIG. 34.**” (lines 7 - 9, emphasis added). Similar statements are found in para. [0068], lines 6 - 7, referring to the user’s “focus and state of busy-ness or availability”. Appellants’ claim language does not state checking the user’s activity, or what the user is focusing his or her attention on. As noted above in para. 26, the user might be busily interacting with his instant messaging application, and this is explicitly outside the scope of Claim 1 (per lines 5 - 6 of Claim 1). Appellants also note that **Figs. 34 - 35** include a “recent application history” item. However, Appellants respectfully submit that application history can be reasonably construed as applications that were previously, but that are not now, executing on the user’s device. Accordingly, these figures are insufficient to teach or suggest Appellants’ claim element on lines 9 - 10 of Claim 1.

33. In para. [0264], Horvitz discusses **Figs. 36 - 38**. Appellants note that each of these figures includes a “current user activity” item and a “distraction cost” item. However, as can be seen by reference to **Fig. 35**, the “current user activity” may include a number of things such as whether an infrared presence detector detects the user in his office. Accordingly, mention of “current user activity” is insufficient to teach the claim element on lines 9 - 10 of Appellants’ Claim 1. Furthermore, this claim element does not recite what the user is currently doing, but rather refers to what the user’s computing device is currently executing.

34. Finally, in para. [0265], Horvitz discusses “user-specified thresholds and parameters defining policies on alerting” (lines 2 - 3), “mouse or keyboard activity” to determine a user’s

[physical] presence (lines 3 - 5), and “inferred states of activity or non-activity” (lines 6 - 7).

However, such references cannot reasonably be interpreted as teaching Appellants’ claimed “whether any of the selected application programs in the list are currently executing” (Claim 1, lines 9 - 10, emphasis added) without prohibited hindsight reasoning.

35. With regard to the statement in the Advisory Action that Horvitz teaching examining “what active applications the user is using” (form PTOL-303, line 4), Appellants find no such teaching or suggestion in Horvitz. An automated search of Horvitz for occurrences of “active” or “current” finds no such teaching or suggestion.

36. In view of the above, Appellants respectfully submit that the Horvitz reference fails to teach, or suggest, the claim element on lines 9 - 10 of Claim 1.

37. The Office Action cites Green (Office Action, Page 3, last paragraph) as teaching “using icons next to names on the buddy list”, citing para. [0010] of Green. Appellants respectfully submit that the teachings of Green are moot, as none of the cited references teaches or suggests the “programmatically determining” element on lines 9 - 10 of Appellants’ Claim 1. Furthermore, because the result of this “programmatically determining” is used in the recitations on lines 14 and 16 of Claim 1, none of the references teaches or suggests the element claimed on lines 12 - 16 of Claim 1.

38. Furthermore, Appellants find no reference in Brown, Horvitz, or Green of user-defined

policy information that comprises a list of application programs, as Appellants have claimed on lines 3 - 6 of Claim 1.

39. As has been demonstrated above in paragraphs 12 - 38, the combination of references fails to teach or suggest all of the claim limitations of independent Claim 1 – and in particular, none of the references (and therefore not the combination) teaches the “defining, by an instant messaging (“IM”) user, policy information ... compris[ing] a list of selected application programs ...” (Claim 1, lines 3 - 6); “whether any of the selected application programs in the list are currently executing” (Claim 1, lines 9 - 10); or responding to arrival of an instant message in different ways depending on that “whether” clause (Claim 1, lines 12 - 16, and in particular, lines 14 and 16).

40. Furthermore, as stated above in paragraph 11, Appellants are entitled to have all words of their claim language considered. Paragraphs 12 - 39, above, demonstrate that Brown, Horvitz, Green, and a combination thereof, do not teach, or suggest, all the limitations or all the words specified in independent Claim 1.

41. Accordingly, in view of paragraphs 10 - 40 herein, Appellants respectfully submit that the Office Action fails to make out a *prima facie* case of unpatentability as to independent Claim 1, and without more, this claim is deemed patentable. See *In re Oetiker*, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992), which stated:

If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.

42. Independent Claims 28 and 29 specify limitations analogous to those of Claim 1 (as stated above in paragraph 5), and these claims are rejected in the Office Action using the same references as Claim 1 (Office Action, Page 2). Refer to paragraphs 10 - 41, above, where the arguments presented therein apply in an analogous manner to the claim language of independent Claims 28 and 29.

43. Accordingly, as demonstrated by paragraph 42 herein, Appellants' independent Claims 28 and 29 are deemed patentable over the references.

#### **7.2) Rejection of Dependent Claims 9 and 15**

44. Dependent Claims 9 and 15 stand or fall with independent Claim 1, from which they depend. Thus, these claims are deemed allowable by virtue of the allowability of independent Claim 1, the patentability of which is discussed above in **"7.1, Rejection of Independent Claims 1, 28, and 29"**.

#### **8) CONCLUSION**

For the reasons set out above, Appellants respectfully contend that each appealed claim is patentable, and respectfully request that the Examiner's Final Rejection of appealed Claims 1, 9, 15, and 28 - 29 should be reversed.

Respectfully submitted,

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## CLAIMS APPENDIX

### CLAIMS AS CURRENTLY PRESENTED:

1 Claim 1: A method of using policy information in responding to arrival of instant messages,  
2 comprising:

3 defining, by an instant messaging ("IM") user, policy information specifying criteria for  
4 responding to arrival of instant messages, wherein the policy information comprises a list of  
5 selected application programs which are each distinct from an instant messaging application used  
6 by the IM user and which are each executable on a computing device of the IM user;

7 receiving an instant message from an IM sender who is not already participating in an IM  
8 session with the IM user;

9 programmatically determining, responsive to the receiving, whether any of the selected  
10 application programs in the list are currently executing on the computing device of the IM user;  
11 and

12 responding to the arrival of the instant message by opening a new window on a graphical  
13 user interface of the computing device of the IM user and displaying the instant message therein if  
14 the programmatically determining has a negative result, or by adding an icon representing the  
15 instant message to an already-open window but not displaying the instant message itself if the  
16 programmatically determining has a positive result, wherein:

17 the already-open window comprises one of an already-open buddy list window that  
18 visually depicts a list of each IM partner from an IM address book of the IM user or an already-  
19 open status window that visually depicts a list of each currently-active IM partner of the IM user;

20 the icon is added in association with a representation, in the visually-depicted list,

21 of the IM sender; and  
22 the icon visually indicates that the instant message is available for on-request  
23 display and can be activated by the IM user to cause the on-request display of the instant message.

Claims 2 - 8 (canceled)

1 Claim 9: The method according to Claim 1, wherein the policy information is specified as a set of  
2 rules.

Claims 10 - 14 (canceled)

1 Claim 15: The method according to Claim 1, further comprising generating an audible indicator  
2 when the programmatically determining has the positive result.

Claims 16 - 27 (canceled)

1 Claim 28: A system to use policy information in responding to arrival of instant messages,  
2 comprising:  
3 means for defining, by an instant messaging (“IM”) user, policy information specifying  
4 criteria for responding to arrival of instant messages, wherein the policy information comprises a  
5 list of selected application programs which are each distinct from an instant messaging application  
6 used by the IM user and which are each executable on a computing device of the IM user;

7 means for receiving an instant message from an IM sender who is not already participating  
8 in an IM session with the IM user;

9 means for programmatically determining, responsive to operation of the means for  
10 receiving, whether any of the selected application programs in the list are currently executing on  
11 the computing device of the IM user; and

12 means for responding to the arrival of the instant message by opening a new window on a  
13 graphical user interface of the computing device of the IM user and displaying the instant message  
14 therein if the means for programmatically determining yields a negative result, or by adding an  
15 icon representing the instant message to an already-open window but not displaying the instant  
16 message itself if the means for programmatically determining yields a positive result, wherein:

17 the already-open window comprises one of an already-open buddy list window that  
18 visually depicts a list of each IM partner from an IM address book of the IM user or an already-  
19 open status window that visually depicts a list of each currently-active IM partner of the IM user;

20 the icon is added in association with a representation, in the visually-depicted list,  
21 of the IM sender; and

22 the icon visually indicates that the instant message is available for on-request  
23 display and can be activated by the IM user to cause the on-request display of the instant message.

1 Claim 29: A computer program product for using policy information in responding to arrival of  
2 instant messages, the computer program product embodied on one or more computer-readable  
3 storage media and comprising:

4 computer-readable program code for defining, by an instant messaging (“IM”) user, policy

5 information specifying criteria for responding to arrival of instant messages, wherein the policy  
6 information comprises a list of selected application programs which are each distinct from an  
7 instant messaging application used by the IM user and which are each executable on a computing  
8 device of the IM user;

9 computer-readable program code for receiving an instant message from an IM sender who  
10 is not already participating in an IM session with the IM user;

11 computer-readable program code for programmatically determining, responsive to  
12 operation of the computer-readable program code for receiving, whether any of the selected  
13 application programs in the list are currently executing on the computing device of the IM user;  
14 and

15 computer-readable program code for responding to the arrival of the instant message by  
16 opening a new window on a graphical user interface of the computing device of the IM user and  
17 displaying the instant message therein if the computer-readable program code for  
18 programmatically determining yields a negative result, or by adding an icon representing the  
19 instant message to an already-open window but not displaying the instant message itself if the  
20 computer-readable program code for programmatically determining yields a positive result,  
21 wherein:

22 the already-open window comprises one of an already-open buddy list window that  
23 visually depicts a list of each IM partner from an IM address book of the IM user or an already-  
24 open status window that visually depicts a list of each currently-active IM partner of the IM user;

25 the icon is added in association with a representation, in the visually-depicted list,  
26 of the IM sender; and

27                   the icon visually indicates that the instant message is available for on-request  
28   display and can be activated by the IM user to cause the on-request display of the instant message.

## **EVIDENCE APPENDIX**

Appellants, the Appellants' legal representative, and the assignee have no personal knowledge of evidence requiring separate identification herein as bearing on this Appeal.

## **RELATED PROCEEDINGS APPENDIX**

The appeal of commonly-assigned and related application 10/655,526 (attorney docket RSW920030202US1) is a potentially-related proceeding. No other related proceedings are personally known to Appellants, the Appellants' legal representative, or the assignee.